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Reply to Office Action Dated 08-18-04
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REMARKS

Status of Prosecution

Applicant filed the original application on October 11, 2003. The Examiner mailed a first, nonfinal office action on August 18, 2004. This paper is in Reply to that office action.
5 Applicant requests reconsideration and withdrawal of the rejections raised in that office action. Claims 1 through 30 are pending. In the instant Office Action, the Examiner rejected claims 1-30.

Claim Rejections

Rejections under 35 U.S.C. §102

10 The Examiner rejected claims 1-30 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,318,005. ('005 Patent.) The rejection is respectfully traversed.

It is noted at the outset that the Application was filed with 30 claims, of which claims 1 (apparatus), 9 (method), and 16 (apparatus) were independent. It is unclear from the Examiner's
15 summary rejection *which* of the claim(s) and which claim elements of those claims are referred to when pointing to reference numbers in the '005 Patent.

Claims 1-8

20 It appears that the Examiner is referring to independent claim 1 set when stating the rejection. Therefore, the present reply specifically refers to that claim set, but does not address independent claims 9 and 16 claim sets for the reasons discussed below.

For a reference to anticipate a claim under 35 U.S.C. §102, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp.*
25 *v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). "Anticipation" is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. The test for infringement by anticipation should

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be rephrased as, "That which would *literally* infringe if later in time anticipates if earlier than the date of invention." (emphasis in the original) See also, *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (emphasis added.)

The '005 Patent does not disclose the identical structure and cooperation of structure as described in the Application examined by the Examiner. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). All elements of independent claim 1 are not present in the '005 Patent.

Although the '005 Patent does not include a main body component or lower body component, the '005 Patent particularly does not include "means for automatically moving said main body component towards said lower body component to engage a line." The Examiner refers to element [37] as a main body component, element [29] as a lower body component, and elements [34] and [49] as means for moving the two body components.

Element [49] of the '005 Patent is not used to move element [37] towards element [29], assuming those elements were indeed "main" and "lower" body components. According to the '005 Patent:

Adjacent the upper end of the mounting post 47 a nut member 48 is screw threaded thereon, and the yoke member is normally maintained in engagement with the nut member by a relatively strong coil spring 49 encircling the mounting post between the yoke member 42 and the rocker frame end member 38.

'005 Patent, col. 4, lines 21-26 (emphasis added). "In this connection, during movement of the strand 11 and the rocker assembly 36 as shown in FIG. 3, the relatively strong coil springs 49 maintain the yoke members 42 constantly engaged against the nut members 48 unless the force exerted on the yoke members by the strand becomes excessive." *Id.* at col. 5, lines 48-53 (emphasis added).

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Further, the rocker frame end members [38] and/or the yoke members [42] must be adjusted and positioned so that the appropriate spacing is attained to accommodate different sizes of the strand. This is not an automatic process:

By turning the screw thread mounting posts 47 in the rocker frame end members 38 and/or properly positioning the nut members 48 on the posts, the yoke members 42 can be located so that the portion of the strand 11 between the sets of rollers 39, 43 is supported thereby in tangent relationship with respect to the counter wheel 12 as shown in FIGS. 1 and 3 and described hereinabove, so as to accommodate different sizes of the strand.

Id. at col. 4, lines 31-38 (emphasis added). In other words, if the screw thread mounting posts and/or nut members are not adjusted to the appropriate position a line will likely *not be engaged* unless it happens to be the right sized gauge of line.

As independent claim 1 is distinguished over the '005 Patent, dependent claims 2-8 are similarly distinguished. As the '005 Patent does not anticipate each and every claim element of claims 1-8 of the application, reconsideration and withdrawal of the rejection is requested.

Claims 9-30

MPEP 707 and 37 CFR § 1.104(c)(2) requires:

In rejecting claims for want of novelty or for obviousness the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be *clearly explained and each rejected claim specified*.

(emphasis added). MPEP 707.07(d) specifically states:

An omnibus rejection of the claim "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground. A plurality of claims should never be grouped

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together in a common rejection, *unless that rejection is equally applicable to all claims in the group.*

(emphasis added). And, MPEP 707.07(g) states: "Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression."

It is particularly difficult to distinguish how the cited reference anticipates independent *method* claim 9 of the Application given the cursory list of elements from the '005 Patent provided in the Office Action. It is also difficult to align the rejection with independent apparatus claim 16 of the Application. In light of recent Federal Circuit decisions regarding prosecution history estoppel and the resulting limitations on the Doctrine of Equivalents, it is difficult for the Applicant to respond to a cursory office action without unnecessarily limiting his claim coverage.

In light of this difficulty, Applicant respectfully requests that an explanation of how the rejection applies to independent claims 9 and 16 of the Application be provided. At this point in time, in lieu of such an explanation, Applicant respectfully traverses the rejection and requests reconsideration and withdrawal of the rejection.

Conclusion

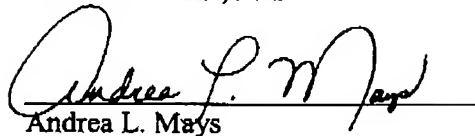
For the reasons set forth above, Applicant requests reconsideration and withdrawal of the foregoing rejections.

Applicant submits that the actions taken by Applicant do not raise new issues that would require further consideration or a new search and do not raise new matter.

In conclusion, Applicant asserts that this Reply is complete as contemplated in 37 CFR §1.111, that claims 1-30 are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant requests an early notice of allowance. The Examiner is invited to call the undersigned at (505) 867-6850 for any reason that would advance the instant application to issue.

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